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EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,001

Applicant(s)

OEDA ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/2/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-14 are presented for examination; claims 1, and 9-13 independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

3. Claims 1-11, and 13-14 are rejected under 35 U.S.C. 112, sixth paragraph as being a means plus function claim without proper support. See MPEP 2181. To overcome this rejection, Applicant must:

- Invoke the right under 35 U.S.C., sixth paragraph to have these claims be treated as means plus function claims. See *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), and
- Identify the corresponding structure, material or acts in the written description necessary to perform that function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, and 5-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Douvikas et al. (USPN 6,691,158) (hereinafter Douvikas).

5. Referring to claim 1, Douvikas discloses an information apparatus (Figure 1, 110) comprising:

user-designated information acquiring means for acquiring user-designated information (i.e. user identity information as found in Figures 7A and 7B) including contents selection information of a user (col. 5, line 67 t col. 6, line 21; col. 9, lines 10-24);

user-designated information notifying means for notifying (i.e. searching) an external device (i.e. someone looking up the "ecard" of the user) of the user-designated information (col. 9, lines 45-58);

user-designated information accuracy setting means for specifying accuracy setting information (i.e. privacy levels), said accuracy setting information including a ratio (i.e. how much and of what information pertaining to the user is disseminated to who) of disclosure of the acquired user designated information to the external device, whereby the user-designated information notifying means is controlled according to the accuracy setting information specified by the user-designated information accuracy setting means (Figure 7A, 720) to thereby transmit log information (i.e. contact

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information gathered by the ecard server) to the external device (outside user requesting user's ecard), said log information being obtained by restricting the user-designated information according to the accuracy setting information (only the information the user allows to be seen to the public is displayed to the other users) (col. 9, lines 1-27; Figures 7A-B).

6. Referring to claim 2, Douvikas discloses the log information is transmitted to the external device together with log accuracy information generated based on the accuracy setting information (i.e. only information allowed to be shown to the public, or marked semi-private, if the requestor is a trusted friend of the user, is shown on the screen, however blanks are shown where information is restricted to the viewer) (Figure 4).

7. Referring to claim 3, Douvikas discloses including AV function control means (i.e. controlling the display of information) including an Internet access function (Figure 1, 170), and wherein at least part of the user-designated information is contents selection information for the AV function control means (i.e. privacy levels) (col. 6, lines 1-22).

8. Referring to claim 5, Douvikas discloses including storing means configured to: store information, said stored information including part of the log information (i.e. database server (col. 4, line 61 to col. 5, line 3), and transmit the stored information to the external device (Figure 4, whole figure is transmitted to the user; col. 5, lines 40-45).

9. Referring to claim 6, Douvikas discloses the user-designated information acquiring means acquires user-designated information from each of the external AV devices respectively having AV function control means (i.e. personal computers), which are independent of the information processing apparatus (col. 5, lines 5-21).

10. Referring to claim 7, Douvikas discloses the user-designated information acquiring means acquires user-designated information from a home appliance (i.e. a personal computer) independent of the information processing apparatus (col. 5, lines 5-21).

11. Referring to claim 8, Douvikas discloses a method for

(a) receiving contents information, said contents information comprising both contents substantial information (i.e. user information) and contents selection information (i.e. whether it should be displayed) for specifying a method of reproducing at least part of the contents substantial information (i.e. determining what information should be transmitted to the external device, or the viewer), and

(b) reproducing the contents substantial information, is determined according to the contents selection information and the user-designated information (Figure 4, whole figure).

12. Claims 9-14 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douvikas in view of Cooper et al. (USPN 6,754,904) (hereinafter Cooper).

15. Douvikas discloses the invention substantively as described in the claims above. Douvikas does not specifically state including pseudo information generating means configured to generate pseudo user-designated information, and wherein the user-designated information acquired from the user-designated information acquiring means

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is substituted with the pseudo user-designated information according to the accuracy setting information. In analogous art, Cooper discloses another information processing apparatus which is configured to generate pseudo user-designated information (i.e. labels stating "private", and wherein the user-designated information acquired from the user-designated information acquiring means is substituted with the pseudo user-designated information according to the accuracy setting information (i.e. instead of disclosing information, the "private" label is inserted indicating that the user wishes this information not to be disclosed) (Figure 11, 1110, 1108). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Cooper with Douvikas in order to allow people to know information about a user without disclosing information considered sensitive to the user, thereby increasing the user's privacy while still allowing others to know information about the user.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Fowler et al. (USPN 6,714,977) discloses monitoring computer networks and equipment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
November 3, 2004

Will C. Vaughn
Primary Examiner
Art Unit 2143
William C. Vaughn, Jr.